

## II. Claim Rejections

The Examiner has rejected claims 1-56 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2002/0046431 to Laurent et al. ("*Laurent*") in view of U.S. Patent No. 5,587,155 to Ochiai et al. ("*Ochiai*") for the reasons disclosed on pages 2-6 of the Office Action. Applicants respectfully traverse this rejection.

The Examiner contends that *Laurent* teaches all the present claim limitations with the exception of the claimed C<sub>10</sub>-C<sub>14</sub> fatty acid. *Office Action*, pages 2-4. To overcome this shortcoming, the Examiner relies on the teachings of *Ochiai*. *Id.*, page 4. According to the Examiner, *Ochiai* discloses a hair dyeing composition containing C<sub>12</sub>-C<sub>40</sub> fatty acids, such as lauric acid and oleic acid. *Id.*, pages 4-5. The Examiner concludes that it would have been obvious to one skilled in the art to incorporate the fatty acids of *Ochiai*, such as lauric acid, in *Laurent's* dyeing composition, with a reasonable expectation of success. *Id.*, page 5.

The Examiner makes two arguments in support of his conclusion of obviousness. First, he contends that *Laurent* suggests the use of fatty acids in a dyeing composition because the Example (at page 22) describes a dye composition containing oleic acid [a C<sub>18</sub> fatty acid]. *Office Action*, page 5. Second, he asserts that *Ochiai* clearly teaches the equivalence of oleic acid (C<sub>18</sub>)

and lauric acid (C<sub>12</sub>) in a hair dyeing formulation at column 2, lines 27-35. *Id.*

Applicants disagree with both these arguments for the reasons detailed below.

**1. The Cited References do not Suggest the Desirability of the Claimed Invention**

The Examiner has not established a prima facie case of obviousness because he has not provided any evidence that his proposed substitution would have been desirable in light of the prior art teachings. Specifically, neither *Laurent* nor *Ochiai* suggests the desirability of, for example, replacing oleic acid with lauric acid. Indeed, *Laurent* provides no suggestion that oleic acid provides any beneficial properties when used in a dye composition. In particular, *Laurent* is drawn to a composition comprising (1) at least one oxidation dye, (2) at least one particular cationic amphiphilic polymer, and (3) a particular weight ratio of a combination of oxyethylenated fatty alcohols and hydroxylated solvents. In the sole example disclosed in *Laurent*, oleic acid (a C<sub>18</sub> fatty acid) is listed as an ingredient in both the inventive and comparative compositions. See page 22, paragraph [0493]. As the results indicate, the combination of ingredients in the inventive composition results in a slower development of color, thus reducing the premature oxidation of the dyes. See paragraph [0017] and [0501]. Thus, these results are not helpful, as they only really demonstrate that oleic acid is used in both the inventive and comparative compositions.

Given this teaching, one skilled in the art would not have had any motivation to select the oleic acid of *Laurent* to replace with any fatty acid, let alone the fatty acid

disclosed in *Ochiai*, because *Laurent* does not disclose that any specific advantages are associated with the oleic acid. Oleic acid is only neutrally disclosed in the *Laurent* reference. At best, all the Examiner has established that it was known to use oleic acid in dye compositions. But that fact alone is insufficient to establish a prima facie case of obviousness. M.P.E.P. § 2143.01 (“The level of skill in the art cannot be relied on to provide the suggestion to combine references.”). Accordingly, for at least this reason the rejection is improper and should be withdrawn.

## 2. The Examiner’s Equivalency Argument Lacks Evidentiary Support

The Examiner has also improperly argued that lauric acid and oleic acid are equivalent based on the teachings of *Ochiai*. The *Ochiai* reference, however, specifically limits its teachings to its invention. For example, it states that “it has been found that the combined use of a cationic surfactant, a **specific fatty acid**, . . . and an aromatic alcohol can provide a hair cosmetic composition in which the fatty acid . . . can permeate the hair . . . .” Col 1, lines 55-67. Thus, the specific fatty acids used in *Ochiai*’s invention may be equivalent for the purposes of that invention. But this reference provides no suggestion that *Ochiai*’s fatty acids are equivalent for use in any other composition.

Indeed, the Declaration submitted on December 22, 2005 by the Applicants demonstrate that oleic acid and lauric acid are not, in fact, equivalent as the Examiner contends. The Declaration describes testing with Inventive Composition A, comprising

lauric acid (C<sub>12</sub>), and Comparative Composition B, comprising oleic acid (C<sub>18</sub>). The results demonstrate that the Inventive Composition A provides improved results when compared with Comparative Composition B. For example, when each dyeing composition was mixed with the oxidizing composition, the mixture containing Inventive Composition A was homogenous while Composition B was lumpy. Composition B was also more difficult to prepare and more difficult to apply to the hair due to its clumpy nature. Inventive Composition A also provided superior coloration selectivity to Comparative Composition B. All these factors illustrate that, contrary to the Examiner's position, oleic acid and lauric acid are not equivalent when used in the claimed invention and one skilled in the art would not have had a reasonable expectation of success in swapping one fatty acid for another. Thus, for at least this additional reason, the rejection is improper and should be withdrawn.

Because neither *Laurent* nor *Cotteret* teach the presently claimed amounts of surfactants (claims 41 and 42), the Examiner alleges that a person of ordinary skill in the art "would be motivated" to optimize the amounts of these ingredients. *Office Action*, page 5. This rejection is improper for at least two reasons.

First, the Examiner's rejection is clearly guided by hindsight. The proper standard for determining obviousness is not whether the claimed invention "would be" obvious but whether it would have been obvious to one skilled in the art at the time of the applicant's invention. Nothing in either *Laurent* or *Ochiai*

provide any evidence of a motivation to optimize the cationic surfactants. Nor does the Examiner make any factual findings as to why one skilled in the art would have performed this optimization in the first place.

Secondly, because neither *Laurent* nor *Ochai* provide a motivation to combine their respective teachings, the further contention of a motivation to optimize amounts of ingredients is premature, and thus improper. Thus, for at least this additional reason, this rejection is improper.

With respect to the multi-compartment kit claims, the Examiner contends that it would have been obvious to make a multicompartment kit because *Laurent* teaches a device or kit for dyeing hair comprising at least two compartments. *Office Action*, page 6. In response, Applicants submit that even if *Laurent* discloses a device or kit for dyeing hair, neither *Laurent* nor *Ochiai* provide any evidence of a motivation to make the claimed composition comprised in the kit, as discussed in detail above. Accordingly, this rejection is improper as well and Applicants respectfully request that this rejection be withdrawn.

### **III. Conclusion**

In view of the above remarks, Applicants request reconsideration and reexamination of the application and the timely allowance of the pending claims.

If there are any additional fees due in connection with the filing of this  
Response, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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